

REMARKS/ARGUMENTS

The Office Action mailed March 26, 2007, has been received and its contents carefully considered. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the foregoing amendments and the following remarks.

In the Office Action mailed March 26, 2007, claims 1-30 stand rejected. Applicant has thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable.

Claims 1 and 17 are presently amended. No claims have been added. As such, claims 1-30 remain pending.

TERMINAL DISCLAIMER

The Examiner claims that "the disclaimer fee of \$130 in accordance with 37 C.F.R. 1.20(d) has not been submitted, nor is there any authorization in the application file to charge a specified Deposit Account or credit card." Applicant submits that the Response filed on 11/28/06 does explicitly provide authorization to charge a specified Deposit Account. At page 12 of the Response, Applicant explicitly authorizes: "Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21800." (Emphasis added). Applicant presently resubmits the terminal disclaimer and re-authorizes any fee deficiencies, including the disclaimer fee of \$130, to be charged to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21800. As such, Applicant requests acceptance of the terminal disclaimer.

CLAIM REJECTION – 35 U.S.C. § 102(e)

Claims 1-3, 5, 12-14, 17, 19, and 26-28 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication 2003/0069589 to Small (“Small”). Specifically, the Examiner claims, at page 3 of the Office Action, that Small discloses a cutting guide having “a substantially flat exterior edge to provide a stable platform for guiding a cutting implement (the edge of 17 is flat, Fig 5).” The Examiner, at page 18, also states that it does not agree that “the thumb wing of Small is not at all related to providing a cutting guide.”

Applicant traverses the rejection. Applicant reiterates, as would be appreciated by one of ordinary skill in the art, that a cutting guide needs to have a flat, smooth edge to allow cutting. Applicant claims a surgical clip with an integral cutting guide. By contrast, Small only contemplates an umbilical cord clamp having a “thumb wing”, which is composed of “outwardly facing surfaces to facilitate the secure gripping and manipulating of the clamp in use.” *See* paragraph 33, lines 1-2. This “thumb wing” surface is therefore meant to be gripped and pushed by user’s hand, and is not at all related to providing a cutting guide. Thus, the function and structure of the device in Small is quite different from that claimed in Applicant’s invention. One of ordinary skill in the art would have neither contemplated nor desired the use of a thumb wing as a cutting guide.

However, in order to advance prosecution and place the application in condition for allowance or in better condition for appeal, Applicant currently amends Claims 1 and 17 to clarify the inherent properties of a cutting guide, which also have not been disclosed in the prior art. Applicant’s specification, at paragraph page 10, lines 27-28, recites that other structures cannot “function as cutting guides 80, since they do not have a length great enough to provide a stable platform for guiding the cutting implement.” (Emphasis added.) Furthermore, as is

apparent from viewing FIG. 3, the cutting guide (80) provides a flat, smooth cutting edge, the cutting guide being a raised flat platform having an angular cross-sectional profile in a plane extending through both opposing side surfaces and substantially parallel to said inner vessel-clamping surface. Small does not disclose or include a flat platform, or a surface which has an angular profile in the plane recited in the claims. As can be seen in FIGS. 2 and 3 of Small (viewing through said recited plane) the thumb wings 17 in Small are curved and not angular. Such a curved wing element would not at all function well to provide a cutting guide surface. As such, Claims 1 and 17, as amended, reiterate elements which are not disclosed in Small, specifically: a surgical clip with at least one integral cutting guide, “being a raised flat platform having an angular cross-sectional profile in a plane extending through both opposing side surfaces and substantially parallel to said inner vessel-clamping surface.” Small does not teach or disclose such a cutting guide. This element is missing in Small. Thus, Claims 1 and 17 are not anticipated by Small.

Therefore, at least for the foregoing reasons, Applicant respectfully asserts that Claims 1 and 17 are patentable and are not anticipated by Small and requests that the rejection with regard to Claims 1 and 17 be withdrawn.

Claims 2, 3, 5, 12-14, 19, and 26-28 depend directly or indirectly from one or another of independent Claims 1 and 17. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. The dependent claims are therefore believed patentable. Applicant therefore respectfully requests that the rejection with regard to Claims 2, 3, 5, 12-14, 19, and 26-28 be withdrawn.

CLAIM REJECTION – 35 U.S.C. § 103(a)

Claims 1, 4, 6-11, 15-18, 20-25, and 29-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,062,846 to Oh, et al (“Oh”) in view of Small.

Amended Claims 1 and 17 disclose a surgical clip with an integral cutting guide, the cutting guide “being a raised flat platform having an angular cross-sectional profile in a plane extending through both opposing side surfaces and substantially parallel to said inner vessel-clamping surface.” The Office Action admits, “Oh et al. does not teach cutting guides extending outward from and disposed along at least one of said first and second legs.” As discussed above, Small does not disclose a cutting edge as disclosed in Applicant’s invention. Thus, the combined references fail to teach the disclosed inventions of claims 1 and 17.

Applicant requests that the rejection with regard to claims 1 and 17 be withdrawn.

Dependent claims 4, 6-11, 15, 16, 18, 20-25, and 29-30 each depend, directly or indirectly, from one or another of independent claims 1, and 17. These claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. Furthermore, if an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Since the independent claims are believed to be nonobvious and therefore patentable, their dependent claims are therefore believed to be patentable. Therefore, Applicant also respectfully requests that the rejection with regard to claims 4, 6-11, 15, 16, 18, 20-25, and 29-30 be withdrawn.

DOUBLE PATENTING

Claims 1-3, 6-13, 15-17, 20-27, 29 and 30 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of Wilson, Jr. (U.S.

Patent No. 6,863,675) in view of Small. Applicant's cutting guide, as claimed "being a raised flat platform having an angular cross-sectional profile in a plane extending through both opposing side surfaces and substantially parallel to said inner vessel-clamping surface" and having "a substantially flat exterior edge to provide a stable platform for guiding a cutting implement," is disclosed by neither Wilson nor Small. This limitation is not disclosed or suggested by the art of record. Therefore, Applicant respectfully requests that the rejection with regard to claims 1-3, 6-13, 15-17, 20-27, 29 and 30 be withdrawn.

Obviousness-type double patenting can in any case be avoided by filing a terminal disclaimer in the application. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Knohl*, 386 F.2d 476, 155 USPQ 586 (CCPA 1967). Without conceding the propriety of the double patenting rejection, a terminal disclaimer in compliance with 37 CFR 1.321(c) has been resubmitted to overcome the nonstatutory double patenting rejection of claims 1-3, 6-13, 15-17, 20-27, 29 and 30. I am an attorney of record in the above-identified case and therefore authorized to signed the attached terminal disclaimer.

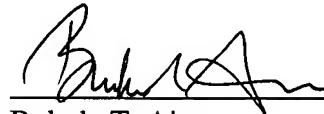
CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. If it is believed that the application is not in condition for allowance, the Examiner is requested to contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to Attorney Docket No. 59474.21800.

Respectfully submitted,

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